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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/901,679	07/11/2001	Eric Aubay	022701-939	8975

7590 06/18/2004  
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EXAMINER

MRUK, BRIAN P

ART UNIT PAPER NUMBER

1751

DATE MAILED: 06/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.	Applicant(s)	
09/901,679	AUBAY ET AL.	
Examiner	Art Unit	
Brian P Mruk	1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-6,9-11,13-15,21-23,29,30,33-36 and 40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-6,9-11,13-15,21-23,29,30,33-36 and 40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date _____   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 19, 2003 has been entered.
2. This Office action is in response to Applicant's amendment filed December 19, 2003. Applicant has amended claims 2, 4-6, 9-11, 13-15, 21, 29-30. Claims 1, 7, 8, 12, 16-20, 24-28, 31, 32 and 37-39 have been cancelled. Currently, claims 2-6, 9-11, 13-15, 21-23, 29, 30, 33-36 and 40 remain pending in the application.
3. The text of those sections of Title 35 U.S. Code not included in this action can be found in the prior Office actions, Paper Nos. 8 and 10.
4. The objection of claim 32 for being an improper multiple dependent claim is withdrawn in view of applicant's amendment. Specifically, claim 32 has been cancelled.

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5. The objection of claim 6 is withdrawn in view of applicant's amendment and remarks.
6. The rejection of claim 6 under 35 U.S.C. 112, second paragraph, is withdrawn in view of applicant's amendment and remarks.
7. The rejection of claim 31 under 35 U.S.C. 112, second paragraph, is withdrawn in view of applicant's amendment. Specifically, claim 31 has been cancelled.
8. The rejection of claims 2-6, 9-11, 13-15, 21-23, 29, 30, 33-36 and 40 under 35 U.S.C. 102(b) as being anticipated by Sharma et al, WO 98/00449, is maintained for the reasons of record.
9. The rejection of claims 2-6, 9-11, 13-15, 21-23, 29, 30, 33-36 and 40 under 35 U.S.C. 102(b) as being anticipated by Matsuda et al, U.S. Patent No. 4,746,455, is maintained for the reasons of record.

## **NEW GROUNDS OF REJECTION**

### ***Claim Rejections - 35 USC § 112***

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

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art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claims 2-6, 9-11, 13-15, 21-23, 29, 30, 33-36 and 40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the instant specification does not provide support for the amphoteric monomer being present in an amount of "not more than 30% of the total mass of said polymer", as recited in newly amended claim 21. The examiner notes that applicant's specification discloses on page 15, that the amphoteric monomer is present in an amount of not more than 20% of the total mass of said polymer. Thus, applicant does not have support for less than 30%.

### ***Double Patenting***

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claims 2-6, 9-11, 13-15, 21-23, 29, 30, 33-36 and 40 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-33 of copending Application No. 10/362,455. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application and claims 1-33 of copending Application No. 10/362,455 are drawn to similar compositions and methods for treating fabrics with a composition containing nanoparticles or a nanolatex of a polymer containing at least 0.1% by weight of an amphoteric monomer, and at least 70% by weight of a hydrophobic monomer (see claims 1-33 of copending Application No. 10/362,455). Therefore, instant claims 2-6, 9-11, 13-15, 21-23, 29, 30, 33-36 and 40 are an obvious formulation in view of claims 1-33 of copending Application No. 10/362,455.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Response to Arguments***

14. Applicant's arguments filed December 19, 2003 have been fully considered but they are not persuasive.

Applicant argues that Sharma et al, WO 98/00449, does not teach or suggest in general a composition that that contains polymers that are prepared from amphoteric monomers. However, the examiner respectfully asserts that Sharma et al does indeed

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teach this limitation. Specifically, the monomers disclosed on page 6 of Sharma et al contain both anionically functional monomers (i.e. contain a sulfonate group) and cationically functional monomers (i.e. an ammonium group). Thus, the examiner respectfully asserts that Sharma et al clearly teaches the monomers required in the instant claims.

Applicant argues that Matsuda et al, U.S. Patent No. 4,746,455, was not used in the last Office action to reject instant claim 21 (i.e. the newly amended independent claim). However, the examiner respectfully points out to applicant that instant claim 21 was rejected by Matsuda et al in Paragraph No. 20 of the last Office action, Paper No. 10. Furthermore, the examiner asserts that the monomers disclosed in col. 2, line 51-col. 3, line 34 of Matsuda et al clearly contain both anionically functional monomers and cationically functional monomers, per the requirements of the instant claims.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Mruk whose telephone number is (571) 272-1321. The examiner can normally be reached on Monday-Thursday from 7:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta, can be reached on (571) 272-1316. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.



Brian Mruk  
June 15, 2004



Brian P. Mruk  
Primary Examiner  
Tech Center 1700